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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/022,186

12/11/2001

Larry Russell

PW-0278622

1091

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03/24/2006

LAW OFFICE OF KARRY W. WANG
3342 PARK RIDGE DR
RICHMOND, CA 94806

EXAMINER

GESESSE, TILAHUN

ART UNIT

PAPER NUMBER

2618

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/022,186

Applicant(s)

RUSSELL, LARRY

Examiner

Tilahun B. Gesesse

Art Unit

2684

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 July 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 2 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: 4 and 5.
Claim(s) rejected: 1-3 and 6-14.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Tilahun B Gesesse
Primary Examiner
Art Unit: 2684

Response to Arguments

Applicant's arguments filed July 29, 05 have been fully considered but they are not persuasive.

On page 6, first paragraph of response, applicant argued that Olalniyan teaches a device that intercepts radio broadcast and re-broadcasts same to the user via a telephone line, where pickup unit A (15) and pickup unit B (16), represent listening devices that interpret broadcast from radio stations and retransmit.

Therefore, Olaniyan teaches away from connecting a user to any broadcast station.

The examiner disagrees. Olaniyan clearly anticipates applicant broadly recited claims, Olaniyan teaches a method of providing a broadcast of a station over a telephone (a remote broadcast system 10, includes a telephone communication system 12 and a plurality of remotely deployed stations receive a broadcast electromagnetic waves 16 and for converting the received broadcast in to signal transmission over the telephone communication system 12 and can be deployed at different locations throughout the globe (column 7, line 20-27).

Olaniyan teaches placing a call from the telephone (the customer uses audio telephone and dials up the telephone number of which includes regional, state and national switching system, that the telephone call is from an audio telephone, the consumer's telephone call and provides the consumer with audible instruction, to input the digits of the telephone area or the zipcode of the area in which the remote broadcasting station that is desired is located (see column 8, lines 1-25)

Olaniyan teaches telephonically accessing a system capable of connecting to a plurality broadcast stations (column 8, lines 1-25).

Olaniyan teaches requesting to receive the broadcast of the stations (the consumer offers a menu of choices of services that are available and consumer select from the offers, and see figure 2).

Olaniyan teaches transmitting the broadcast of the stations via the telephone (see column 5, lines 25-36).

Applicant argued that Olaniyan device cannot and will not connect a user to any radio station.

The examiner disagrees. Olaniyan teaches a consumer being connects to any radio stations (see AM tuner and FM tuners of figure 3 and abstract).

On page 7, first paragraph of response to the office action , applicant argued that the present invention discloses a system that seeks out broadcast stations to became members of the system. Only registered member stations have the privilege to transmit their broadcast to a user via the system. The radio stations whose broadcasts are transmitted via the system are aware of such transmission, which makes connecting a user to the stations possible and legal.

The examiner disagrees. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a system that seeks out broadcast stations to became members of the system. Only registered member stations have the privilege to transmit their broadcast to a user via the system. The radio stations whose broadcasts are

transmitted via the system are aware of such transmission, which makes connecting a user to the stations possible and legal.) are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

On page 7, second paragraph, in response to the office action, applicant noted that it is clear that the word "connection" means something entirely different in the present application than what the Olaniyan device may be capable.

The examiner disagrees. During examination the USPTO must give claims their broadest reasonable interpretation.). This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (discussed below); *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004)

On page 7, same paragraph, in response to the office action, applicant is willing to consent to amend the claims, without acquiescing in the examiner's reasons of rejection and without prejudice to pursue in this application and proposes an amendment.

The applicant proposes an amendment to after final rejection, applicant's proposal to amend is an admission that the applied prior art is anticipating the broadly recited claims.

On page 8, second paragraph , in response to the office action, applicant argued that it cannot be properly combined with Bates to create a system in accordance with the subject invention. Therefore, as a threshold matter, the rejection under 35 USC 103(a) cannot stand.

The examiner disagrees. "The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.... Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). See also *In re Sneed*, 710 F.2d 1544, 1550, 218 USPQ 385, 389 (Fed. Cir. 1983) ("[I]t is not necessary that the inventions of the references be physically combinable to render obvious the invention under review."); and *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973).

On page 8, third paragraph, in response to the office action , applicant argued that Bates is non-analogous art.

The examiner disagrees. In response to applicant's argument that Bates is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Bates teaches cellular transceiver and also radio receiver in alternative , the cellular transceiver permits the radio receiver to communicate over

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cellular network (column 4, lines 50-63 and figure 1). Therefore, Bates teaches placing a call from cellular transceiver in order to receive a broadcast signal and it is in field of applicant's endeavor.

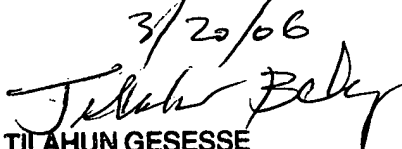
On page 8, fourth paragraph , in response to the office action , applicant argued that no motivation or suggestion for a person of ordinary skill in the art to use.

The examiner disagrees. Motivation to make or use the non-obvious product must be present in the prior art for a 35 U.S.C. 103 rejection to be sustained. Then, Bates teaches placing a call using cellular transceiver in order to retrieve broadcast signal and it is in field of applicant's endeavor, therefore, one ordinary skill in the art would be motivated to make or use of applicant's invention using the concepts by the combination of Olaniyan and Bates.

To sum up , in view of the clear teaching of the applied prior art and response to argument explained by the examiner , the rejection is proper and maintained.

Tilahun Gesesse

Art Unit 2618

3/20/06

TILAHUN GESESSE
PRIMARY EXAMINER